

Appl. No. : 10/736,451
Filed : December 14, 2003

REMARKS

The Applicants thank the Examiner for the examination of the present application. By way of summary, Claims 1-42 were pending in this application. In the Office Action mailed March 15, 2006, the Examiner rejected Claims 1-42. In particular, the Examiner rejected Claims 1-42 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. In addition, the Examiner rejected Claims 1-42 under 35 U.S.C. § 102(e) as being unpatentable over "Privacy in an Identity-based DRM System" by Conrado et al. ("Conrado").

This Amendment amends Claims 1-5, 7-8, 16-17, 20-26, 28-29, 37-38, and 41-42, and Claims 6, 9-15, 18-19, 27, 30-36, and 39-40 remain as originally filed. Thus, after entry of this Amendment, Claims 1-42 remain pending.

A. Rejection Of Claims 1-42 Under 35 U.S.C. § 112, Second Paragraph

The Examiner rejected Claims 1-42 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

In particular, the Examiner rejected Claims 3-5, 20-21, 24-26, and 41-42 stating that "the 'digital certificate contains unique identifiers' . . . phrase makes the claims indefinite and unclear." While Applicants respectfully disagree with the Examiner's rejection, Applicants have amended Claims 3, 20, 24, and 41 to include "of a plurality of unique identifiers" as suggested by the Examiner. Thus, Applicants respectfully request that this rejection of Claims 3-5, 20-21, 24-26, and 41-42 be withdrawn.

In addition, the Examiner rejected Claims 1, 2, 4, 5, 7, 8, 16, 17, 21-23, 25, 26, 37, 38, and 42 stating that there is insufficient antecedent basis for the limitation of "the client." Applicants have amended Claims 1, 2, 4, 5, 7, 8, 16, 17, 21-23, 25, 26, 37, 38, and 42 to clarify the limitation of "the client device." Thus, Applicants respectfully request that this rejection of 1, 2, 4, 5, 7, 8, 16, 17, 21-23, 25, 26, 37, 38, and 42 be withdrawn.

B. Rejection Of Claims 1-42 Under 35 U.S.C. § 102(e)

The Office Action rejected Claims 1-42 under 35 U.S.C. § 102(e) as being anticipated by "Privacy in an Identity-based DRM System" by Conrado, et al. ("Conrado"). The Applicants respectfully traverse this rejection and the Examiner's characterization of the cited reference

Appl. No. : 10/736,451
Filed : December 14, 2003

because Conrado fails to identically teach every element of the claim. *See M.P.E.P. § 2131* (stating that in order to anticipate a claim, a prior art reference must *identically* teach every element of the claim).

1. Claim 1

With respect to Claim 1, the Examiner stated that Conrado discloses “determining whether the client is authorized to perform the digital action” and “performing the digital action via execution of the one or more secure components if the digital certificate is authentic and the client is authorized to perform the requested action.” Applicants respectfully disagree. Conrado merely discloses a user that “authenticates himself to the device.” (*See e.g.*, Conrado, Section 2 and Section 5.1.1.) Conrado does not disclose “determining whether the client device is authorized to perform the digital action” or “performing the digital action *via execution of the one or more secure components* if the digital certificate is authentic *and the client device is authorized* to perform the requested action” (*emphasis added*).

Thus, Applicants respectfully submit that Conrado fails to disclose the claimed subject matter of Claim 1, including each element of Claim 1, and Applicants respectfully request that the rejection of Claim 1 be withdrawn.

2. Claims 2-16

Claims 2-16, which depend from independent Claim 1 and include all the limitations of Claim 1, are believed to be patentable for the same reasons stated above with respect to Claim 1 and because of the additional limitations set forth therein. Since Conrado fails to disclose every element of Claims 2-16, Applicants respectfully request that the rejection of Claims 2-16 be withdrawn.

3. Claim 17

With respect to Claim 17, the Examiner stated that Conrado discloses “generating a plurality of secure components to facilitate performance of one or more digital content related actions by a client device” and “generating a digitally signed certificate associating an arbitrary digital action with a selected one or more of the plurality of secure components.” Applicants respectfully disagree. Conrado merely discloses an authorization certificate. (*See e.g.*, Conrado, Section 2 and Section 5.1). Conrado does not disclose “*generating a plurality of secure components* to facilitate performance of one or more digital content related actions by a client

Appl. No. : 10/736,451
Filed : December 14, 2003

device" and "generating a digitally signed certificate associating an arbitrary digital action with a selected one or more of the plurality of secure components" (emphasis added).

Thus, Applicants respectfully submit that Conrado fails to disclose the claimed subject matter of Claim 17, including each element of Claim 17, and Applicants respectfully request that the rejection of Claim 17 be withdrawn.

4. Claims 18-21

Claims 18-21, which depend from independent Claim 17 and include all the limitations of Claim 17, are believed to be patentable for the same reasons stated above with respect to Claim 17 and because of the additional limitations set forth therein. Since Conrado fails to disclose every element of Claims 18-21, Applicants respectfully request that the rejection of Claims 18-21 be withdrawn.

5. Claim 22

The Examiner rejected Claim 22 on the same basis as Claim 1 above. Accordingly, as set forth above with respect to Claim 1, Applicants respectfully submit that Conrado fails to disclose the claimed subject matter of Claim 22, including each element of Claim 22, and Applicants respectfully request that the rejection of Claim 22 be withdrawn.

6. Claims 23-37

Claims 23-37, which depend from independent Claim 22 and include all the limitations of Claim 22, are believed to be patentable for the same reasons stated above with respect to Claim 22 and because of the additional limitations set forth therein. Since Conrado fails to disclose every element of Claims 23-37, Applicants respectfully request that the rejection of Claims 23-37 be withdrawn.

7. Claim 38

The Examiner rejected Claim 38 on the same basis as Claim 17 above. Accordingly, as set forth above with respect to Claim 17, Applicants respectfully submit that Conrado fails to disclose the claimed subject matter of Claim 38, including each element of Claim 38, and Applicants respectfully request that the rejection of Claim 38 be withdrawn.

8. Claims 39-42

Claims 39-42, which depend from independent Claim 38 and include all the limitations of Claim 38, are believed to be patentable for the same reasons stated above with respect to Claim

Appl. No. : 10/736,451
Filed : December 14, 2003

38 and because of the additional limitations set forth therein. Since Conrado fails to disclose every element of Claims 39-42, Applicants respectfully request that the rejection of Claims 39-42 be withdrawn.

9. Summary

Because Conrado fails to disclose the claimed subject matter of Claims 1-42, including each element of Claims 1-42, and Applicants respectfully request that the rejection of Claim 1-42 be withdrawn and that the Examiner pass Claims 1-42 to allowance.

C. REQUEST FOR TELEPHONE INTERVIEW

Pursuant to M.P.E.P. § 713.01, in order to expedite prosecution of this application, Applicants' undersigned attorney of record hereby formally requests a telephone interview with the Examiner as soon as the Examiner has considered the effect of the arguments presented above. Applicants' attorney can be reached at (949) 721-7603 or at the number listed below.

D. CONCLUSION

In view of the forgoing, the present application is believed to be in condition for allowance, and such allowance is respectfully requested. If further issues remain to be resolved, the Examiner is cordially invited to contact the undersigned such that any remaining issues may be promptly resolved. Also, please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: June 14, 2006

By: Amy Christensen
Amy C. Christensen
Registration No. 52,742
Attorney of Record
Customer No. 20,995
(949) 760-0404

2640897
053106